



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,293	03/04/2002	Giulio Ratti	PP01641.102	8906

7590

05/20/2003

Chiron Corporation  
Intellectual Property R440  
PO Box 8097  
Emeryville, CA 94662-8097

EXAMINER

BASKAR, PADMAVATHI

ART UNIT

PAPER NUMBER

1645

DATE MAILED: 05/20/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/868,293

Applicant(s)

RATTI, GIULIO

Examiner

Padmavathi v Baskar

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other:  |

Art Unit: 1645

## RESTRICTION

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-4, 12,13, 14, 15 and 18 drawn to C.trachomatis protein, composition, and a method of treatment using protein.

Further restriction to one protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Group II, claims 6-11, 12-13 and 19-20 drawn to nucleic acid encoding protein (DNA), vector host cell and a process of producing protein.

Further restriction to one nucleic acid encoding protein as represented by "protein spot 5-55 " in Table 11 (see paragraph # 3).

Group III, claims 5 and 12-13 drawn to an antibody and a therapeutic composition.

Further restriction to one antibody that binds to protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Group IV, claims 15 and 18 drawn to a method of treatment using nucleic acid encoding a protein.

Further restriction to one nucleic acid encoding a protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Group V, claim 15 and 18 method of treatment using an antibody.

Further restriction to one antibody that binds to protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Group VI, claims 16, 22 and 24 drawn to a method of detecting Chlamydia or protein and a kit.

Art Unit: 1645

Further restriction to one protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Group VII claims 16, 21 and 24 drawn to a method of detecting Chlamydia or nucleic acid encoding a protein and a kit.

Further restriction to one nucleic acid encoding a protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Group VIII claims 16, 23 and 24 drawn to a method of detecting Chlamydia or antibody that binds to protein and a kit

Further restriction to one antibody that binds to protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Group IX, claim 17 drawn to a method of manufacture of a reagent, which can raise antibodies using protein.

Further restriction to one protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Group X, claim 17 drawn to a method of manufacture of a reagent, which can raise antibodies using nucleic acid encoding protein

Further restriction to nucleic acid encoding protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Group XI, claim 17 drawn to a method of manufacture of a reagent, which can raise antibodies using antibody that binds to a protein.

Further restriction to one antibody that binds to a protein as represented by "protein spot 5-55 ", in Table 11 (see paragraph # 3).

Applicant is advised to amend the claims to recite the protein numbers only.

Art Unit: 1645

2. The inventions listed as Groups I-XI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I is directed to a polypeptide. The special technical feature is the polypeptide, which is made up of amino acids. Groups II-III are drawn to structurally different products such as nucleic acids and antibodies which do not require each other for their practice and do not share the same or a corresponding technical feature because there is no common structure, property or function among these products. Group I that is drawn to amino acid, which is the first product and method of use using said protein. The Group IV-X I inventions are drawn to methods using products which do not require each other for their practice and do not share the same or a corresponding technical feature because there is no common structure, common property or common function exists among these products. Note that PCT Rule 13.2 does not provide for multiple products or methods within a single application. Since the special technical feature of the Group I invention is not present in the Group II-III claims, unity of invention is lacking.

### **DISTINCT INVENTIONS**

3. For each group of inventions I-XI above, restriction to one of the following protein is required. Different Chlamydia proteins are represented by a lab designated identifier protein spot 5 to protein spot 55. Therefore, election is required of one of inventions I - XI and one of protein as represented by a lab designated identifier "protein spot 5 to protein spot 55" as shown in Table II under 35 U.S.C. 121 and 372

Inventions of protein spot 5 to protein spot 55 are not so linked as to under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Art Unit: 1645

Inventions protein spot 5 to protein spot 55 represented structurally different polypeptides and the polynucleotides encoding them. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects. Thus, each sequence is unique and has no common structure, common property or common function and are identified by specific amino acid or nucleic numbers and thus lacks the same or corresponding special technical features. Applicant is required under 35 U.S.C. 121 and 372 to elect a single disclosed lab designated identifier number protein spot 5 to protein spot 55 from any group elected.

4. Applicant is required, in reply to this action, to elect one group and one lab designated protein spot 5 to protein spot 55 and identify the protein spot 5 –55 to which the claims shall be restricted. The reply must also identify the claims readable on the elected invention, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmavathi v Baskar whose telephone number is (703) 308-8886. The examiner can normally be reached on M-F (6:30A.M-4: 00 P.M.) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith can be reached on (703) 308-3909. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

P. Baskar Ph.D.  
5/15/03

  
**LYNETTE R. F. SMITH**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**